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| 10/691,286 | 10/22/2003 | Thomas C. Chuang | 0031000 | 4915 |
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| Thomas C. Chuang #408 2201 Laguna St. San Francisco, CA 94115 | | | RUHL, DENNIS WILLIAM | |
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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/691,286
Filing Date: October 22, 2003
Appellant(s): CHUANG, THOMAS C.

Thomas C. Chuang
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/10/06.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 9/15/05 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is inaccurate because some of the comments applicant has made about the invention do not have proper support in the specification as originally filed. This is an issue that is pending in the instant appeal. The summary is commensurate with applicant's arguments traversing the rejections of record but in the opinion of the examiner the summary is not commensurate with the scope of the invention disclosed in the specification as originally filed.

(6) *Grounds of rejection to be reviewed upon Appeal (applicant has this section listed as "Issues")*

The appellant's statement of the issues in the brief is correct.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(11) *Response to Argument*

Applicant has argued that the status identifiers of "available" and "unavailable" are disclosed in the specification as originally filed. The examiner disagrees. Upon review of claim 23 it is noted that one of the status identifiers is called "a checked out status". This is shown in figure 3A and is labeled as 302, "DVD's checked out". The examiner has no problem with this limitation. The other status identifier in figure 3A is shown to be "DVD's in Your Queue" and is labeled 304. Figure 3B has the status identifier of "DVD's Awaiting Release" and is labeled as 306. There is simply no support in the specification as originally filed for the status identifiers of "available" and "unavailable" and figure 3A and 3B do not show them. If the one status identifier of "DVD's checked out" is located above the box that lists the movies that have that respective status, why is it incorrect to conclude that the other status identifiers are also located above the boxes that list the movies that have that respective status, just like the "DVD's checked out" status identifier? Applicant's arguments do not make sense in view of the original disclosure. The argument by applicant that the terms "available" and "unavailable" refer to whether or not a particular movie has been released by the movie studios has no support in the specification. Where is this stated in the specification as

originally filed? The examiner takes the position that the fact that a movie is “unavailable” may also mean that the movie is currently rented out (it has been released) and is not available to you as a user of the movie service. A movie that is unavailable may also mean that you are currently renting the maximum number of movies that the service allows to be rented out at one time, meaning that the movie is not available yet, unless you return another movie so that you can get a new one sent out. The argument that the term “unavailable” is for movies that are not yet released has no support in the specification. The applicant is using claim terminology that was never used on the specification as originally filed. The status identifier of “available” also has not support in the specification as originally filed. At best what applicant is calling “available” corresponds to the originally disclosed status identifier of “DVD’s in Your Queue”. The examiner believes that the current problems in the claims are due to the fact that applicant is attempting to use new and different terminology form that used in the specification as originally filed, where the newly added terminology does not mean the same as what was originally disclosed. In fact, upon conducting an electronic text word search in the specification as originally filed the terms “status identifier” and “available” and/or “unavailable” in the same paragraph as “status identifier” are not found.

With respect to the argument about the limitation of “searching all of the user’s queue data structures”, applicant appears to be relying on the language “the rental pattern, both historical and current, of the DVD title across all users is evaluated”. One output is disclosed as being the number of titles checked out and required to be shipped

at a given time. This portion does not state that all of the user's queue data structures are searched as has been claimed. What exactly is meant by "the rental pattern, both historical and current, is evaluated? The historical rental pattern is not listed in any of the rental queues so this is not clear. The current rental pattern seems to be the number that are checked out and the number that are on the list but not checked out yet. *Where is it disclosed that the queue data structure that lists the movies "awaiting release" (status identifier of "DVD's awaiting release") is searched?* That is one of the 3 queue data structures and if the movie is not released yet, it cannot be checked out and is not a current rental. The examiner does not see where the specification as originally filed discloses that the "awaiting release" list is also checked, which is one of the queue data structures? The claim recites "all of the user's queue data structures", which includes all 3, namely, "DVD's in Your Queue", "DVD's checked out" and "DVD's Awaiting release". The examiner does not see support in the specification for what is being claimed.

With respect to the limitation of the additional packaging, applicant is equating the language of "DVD title jewel case" or "jewel case" in figure 4 to "packaging". This is not proper because it is not even clear that the term "DVD title jewel case" is packaging. Also the term packaging has a much more broad definition than a case for a DVD, so even if applicant has disclosed a DVD case, this does not provide support for the broad term of "packaging". Packaging can be anything from wrapping paper for birthday presents to cardboard boxes used in shipping. This is

another example of the claims containing terminology that was never disclosed in the applicant as originally filed. The argument is not found as persuasive.

With respect to the 112,1st enablement rejection, as the claims are written, how is one going to determine the optimized price by determining the frequency of occurrence of the disk identifier as claimed? The claim is specifying that the price is determined from just the frequency of occurrence, nothing else, and there is no guidance given on how this is done. There still has been no discussion as to once you determine how many copies are owned or how many are checked out, how is the price determined from there? One of skill in the art would not be able to figure out how to do the optimization as nothing is disclosed about how the actual price is determined based on the frequency of occurrence alone. The examiner feels that there are essential steps missing from the claims that would possibly provide enablement. Just determining how many copies of a movie are rented out, or required to be shipped, does not result in a price of any kind. That result is just a number. The claims make no mention of anything more being done once the frequency of occurrence number is determined. The claims magically result in a price from just a number. This is not enabled and the argument is found to be non-persuasive. Even when viewing figure 5B, if one goes through steps 510 and 512 to determine how many copies of a movie are owned or in use, following the "no" side of the decision branch from step 514, and if the customer is not entitled to a special discount, you arrive at box 530 with a price. Where has the price been calculated? Just evaluating inventory and inventory use does not result in a price, more

must be done to arrive at an optimized price. The claims are considered to be non-enabled and the arguments are found to be non-persuasive.

With respect to the 112,2nd paragraph rejection, the argument is found to be non-persuasive for the reasons already set forth by the examiner. Applicant has relied upon the argument traversing the 112,1st rejections, which have been found as non-persuasive.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



DENNIS RUHL
PRIMARY EXAMINER

DR
February 8, 2006

Conferees

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